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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,959	12/20/2000	Yoav Lorch	F8800.0136/P005	3720
24998	7590	02/10/2006	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			RIMELL, SAMUEL G	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			2164	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/739,959

Applicant(s)

LORCH ET AL.

Examiner

Sam Rimell

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 46-48, 72-79, 82-84 and 92-104 is/are pending in the application.
- 4a) Of the above claim(s) 103 and 104 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-48, 72-79, 82-84, 92-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

Art Unit: 2164

Response to Election Requirement: In response to the election requirement of October 19, 2005, applicant has elected claims 92-102. Accordingly, claims 103-104 are withdrawn. Claims 46-48, 72-79, 82-84 and 92-102 are examined on the merits.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 92-94 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 92: Claim 92 includes a requirement of "said set of presentation protocols are created, modified and updated by the recipient". Applicant defines the presentation protocols as formats (page 17, line 15 of the specification and page 18, line 2 of the specification). However, there is no suggestion of "format" being modifiable by the recipient of a postal piece, nor is there suggestion in the disclosure of the "format" being modifiable at all. Accordingly, the requirement in claim 92 for protocols that are created modified and updated by a recipient is new matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 2164

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 46-48, 72-79, 82-84 and 95-102 are rejected under 35 U.S.C. 102(e) as being anticipated by Deans et al. (US2003/0208364).

Claim 46: Deans et al. is directed to the concept of delivering a postal mail piece to a recipient postal address (paragraph 0047). The postal mail piece is first provided with a proxy address, referred to as an "IAC". The IAC is based on a protocol using text and numbers (paragraph 0053) and the protocol of text and numbers is a "mnemonic" by reason that it is capable of being remembered. The IAC has a presentation protocol that distinguishes it from other addresses in the sense that it is not associated with any decipherable delivery address (paragraph 0024, lines 1-8). Changes in the delivery address do not change the IAC (paragraph 0012, lines 5-7 and paragraph 0045, lines 1-4).

The proxy address (the IAC) is processed by running a query through a database table with the proxy address, in which the postal recipient address is obtained (paragraph 0033, lines 1-4).

Once the correct postal recipient address is obtained, it can be affixed to postal mail piece so as to effect delivery to the correct address (paragraph 0047 , lines 14-20).

Claim 47: The proxy address (IAC) is considered to be a "mnemonic" in the sense that it appears capable of being remembered, particularly since it may used for very long periods of time (for the life of the recipient, paragraph 0045, lines 1-2). It is considered to be a category of information in the sense that it is a type of information, such as encrypted information.

Art Unit: 2164

Claim 48: The proxy address (IAC) is located on the postal mail piece and is detected first before it is processed into a delivery address (paragraph 0047, lines 14-20). The proxy address is readable as a symbol.

Claim 72: Paragraphs 0033-0035 describe a computer system including computer readable media that define a database. The database includes a reference file which correlates proxy addresses (IACs) to deliverable postal addresses. The IACs are “mnemonics” since they are letters and numbers (paragraph 0053) and are thus capable of being remembered. The proxy addresses (IACs) do not change with changes in address (paragraph 0012, lines 5-7 and paragraph 0045, lines 1-4). Paragraph 0047 describes a secure provider (30) which would operate a database interface computer. The interface computer will read the proxy address (IAC), compare it to the database of proxy addresses and output a recipient postal address (paragraph 0047). The recipient postal address is then affixed to the same mail piece that included the proxy address, and the mail piece would be delivered to a physical address as normal.

Claim 73: The secure provider (30) operates an interface computer to convert the proxy address to a deliverable postal address (paragraph 0047). That deliverable address is affixed to the postal mail piece (paragraph 0047, lines 14-20 and paragraph 0013, lines 1-4).

Claim 74: Paragraph 0037, lines 1-9 describe the proxy address (IAC) being provided to an online vendor who also operates an interface to the computer that processes the IAC. In such instance, a computer network is transmitting the proxy address from a customer, to a vendor and on to the secure provider for translation to a deliverable address that gets sent back to the vendor.

Claim 75: An online purchase of the type described in paragraph 0037 is conducted over the Internet.

Claim 76: Paragraph 0030 describes a website which allows the recipient addresses in the database to be altered by the user. A user's computer which accesses this website would be the second database interface computer. The means for recipient modification is the website itself.

Claim 77: The postal address can be modified without modifying the proxy address (paragraph 0012, lines 5-7, and paragraph 0045, lines 1-4).

Claim 78: Conversely to claim 77, the proxy address can be changed without changing the postal address (paragraph 0012, deleting the IAC or having it expire after a single usage).

Claim 79: Paragraph 0029 describes the secure provider accepting an electronic form from a user to register a new proxy address (IAC). When the form is submitted electronically to the secure provider, the computer that sends the form is a third interface computer to the database.

Claim 82: See remarks for claim 46.

Claim 83: Paragraph 0030 describes the capability of allowing users to modify the delivery addresses along with an authorization step for performing this function.

Claim 84: The proxy address on the postal mail piece is readable as an identifier.

Claim 95: See remarks for claim 72. Claim 95 further specifies that the proxy address are created, modified and updated by a recipient. As defined in paragraph 0026, lines 1-2 of Deans et al., the "user" is the recipient. In paragraph 0027, the user/recipient creates the IAC by requesting the IAC. As described in paragraph 0012, the user/recipient modifies the IAC by

Art Unit: 2164

deleting it. The user can further updates the IAC by changing the delivery address (paragraph 0030), which can change the IAC. Paragraph 0012 also specifies an additional scenario where the IAC can be updated by simply allowing for only a single use. The update then occurs when the user requests a new IAC for a new usage.

Claim 96: See remarks for claim 73.

Claim 97: See remarks for claim 74.

Claim 98: See remarks for claim 75.

Claim 99: See remarks for claim 76.

Claim 100: See remarks for claim 77.

Claim 101: See remarks for claim 78.

Claim 102: See remarks for claim 79.

#### Remarks

Applicant's arguments have been considered.

With respect to claims 46, 72 and 82, applicant argues that the IAC of Deans et al. is not a mnemonic. Examiner maintains that a mnemonic is merely anything capable of being memorized, such a numbers or letters. From a physical point of view, mnemonics are just sets of letters and/or numbers, and since the IAC is a set of letters and numbers (paragraphs 0053) is it accordingly held to be a mnemonic.

With respect to independent claim 92, examiner finds the presence of new matter, due to the fact that the specification does not permit the recipient to change or modify the protocol (i.e. the format) of the proxy address. While the specification does support the concept of the user

Art Unit: 2164

changing the proxy address itself, the specification does not support the concept of the user changing the underlying protocols for defining the proxy addresses.

With respect to independent claim 95, applicant argues that Deans et al. does not disclose the concept of the recipient creating, modifying or updating the proxy address. This not correct. In Deans et al., the described “user” is the recipient (paragraph 0026, lines 102). The IAC is the proxy address. The user can create an IAC by filling out a request form (paragraph 0027), modify an IAC by deleting it (paragraph 0012) or updating an IAC by editing (paragraph 0030).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Art Unit: 2164

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell  
Primary Examiner  
Art Unit 2164